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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,021	04/19/2004	Richard Devlin Schwarz	114129.121US3	2504
BRAD PINES 2290 WOODLAND TERRACE SCOTCH PLAINS, NJ 07076				
7590 02/25/2008				
EXAMINER				
MERCHANT, SHAHID R				
ART UNIT		PAPER NUMBER		
3692				
MAIL DATE		DELIVERY MODE		
02/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/827,021

**Applicant(s)**

SCHWARZ ET AL.

**Examiner**

SHAHID R. MERCHANT

**Art Unit**

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 5,7,13,14,17,18 and 22-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-12,15,16,19-21 and 42-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of the Claims*

1. This action is in response to the amendment filed on December 3, 2007. Claims 1-44 are pending. Claims 5, 7, 13-14, 17-18 and 22-41 have been cancelled. Claims 1, 6, 15, 16, 20 and 21 have been amended. Claims 42-44 are new claims.

### *Response to Arguments*

2. Regarding claim 18, Applicant has failed to adequately rebut Examiner's Official Notice that presenting a chart that displays at least one of the series of financial metrics for a holding in comparison to the holding's total shareholders equity is common and well known in the art to show information on a chart.

Examiner notes the following discussion of Official Notice taken from the MPEP:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was

inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP § 2144.03(C))

Applicant has not "specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." For this reason, the aforementioned limitations are taken to be admitted prior art.

3. Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection.
4. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions.
5. Applicant is advised to review the following section from the MPEP:

#### **608.01(m) [R-3] Form of Claims**

The claim or claims must commence on a separate physical sheet or electronic page and should appear after the detailed description of the invention. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim," "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the Office of Patent Publication. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.C. 1995). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i).

#### ***Drawings***

6. New corrected drawing in compliance with 37 CFR 1.121(d) are required in this application. Figures 2, 5, 7-15, 17-23 and 27-37 contain improper shading and/or handwritten text, which may affect clarity once reproduced. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Objections***

7. Claims 1, 20, 21 and 42-44 objected to because of the following informalities: the use of parenthesis in the claim language. Applicant should revise the claim and avoid using parenthesis. Appropriate correction is required.
8. Claim 16 objected to because of the following informalities: the word "ass" should be changed to "as". Appropriate correction is required.
9. Claim 20 objected to because of the following informalities: the word "Wherein" should be changed to "wherein". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 6 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has inserted new matter regarding time domain aspect and financial attribute aspect in the claim.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-44 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claims 1-44 rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The claim(s) must be in one sentence form only. See paragraph 4 of this Office Action.

15. Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

16. Regarding claim 15, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

17. Claim 1 recites the limitations "the periodically- issued financial statement", "the stock exchange", "the quantified figures", "the values" and "the positional penetration percentage" in lines 6-7, 18, 20 and 27. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 6 recites the limitations "the time dimension" and "the degree" in lines 3 and 11. There is insufficient antecedent basis for these limitations in the claim.

19. Claim 16 recites the limitation "the P&L statement" in line 5. There is insufficient antecedent basis for this limitation in the claim.
20. Claim 20 recites the limitations "the net dollar change", "the amount net capital" and "the enterprise firm" in lines 10-13. There is insufficient antecedent basis for these limitations in the claim.
21. Claim 21 recites the limitations "the pro forma amount", "the start", "the end", "the P&L statement" and "the cash flow statement" in lines 6-7 and 13. There is insufficient antecedent basis for these limitations in the claim.
22. Claim 42 recites the limitations "the effect" and "the total worth" in lines 4 and 10. There is insufficient antecedent basis for these limitations in the claim.
23. Claim 44 recites the limitations "the background portfolio", "the holdings", "the periodically- issued financial statements", "the stock exchanges", " the holding's security trades", "the quantified figures" and "the values" in lines 2-21 . There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 1-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel, JR. et al., U.S. Patent Application Publication, 2002/0032629 (see PTO-892, Ref. D).

26. As per claim 1, Siegel, JR teaches a method:

identifying the holdings that comprise the portfolio;

selecting a time interval comprised of successive time periods (such as a three year time interval of comprised 12 successive quarters);

obtaining public financial information for each of the holdings, such information to include that from the periodically -issued financial statements and data from the stock exchanges on which the holding's security trades;

identifying public financial metrics that are to be used in evaluating the holdings of the portfolio with such financial metrics to include selected line items in the holding's periodically-issued financial statements as well as data from the stock exchanges on which the holding's security trades such data as security prices and number of shares outstanding;

defining a set of evaluation metrics, some which use proprietary financial metrics of which all the proprietary financial metrics can be derived from public financial metrics, used in evaluating the holdings, wherein each evaluation metric measures the relative financial strength of holdings in a different way;

capturing the quantified figures (some being dollar denominated and some be share-related amounts) from public financial information and the financial data needed to calculate the values for each evaluation metric;

computing the value of at least some of the evaluation metrics using the quantified figures for financial metrics wherein, depending the particular evaluation



metric, a higher value for a holding indicates higher relative fundamental strength (or visa versa);

stack ranking (or reverse stack ranking if a lower value indicates higher relative fundamental strength for a given evaluation metric) the holdings of the portfolio for each evaluation metric (or alternatively determining the positional penetration percentage of the holdings of the portfolio for each evaluation metric), wherein each evaluation metric stack ranking (or position penetration percentage) is based upon the holdings' values that have been determined for that evaluation metric;

assigning an evaluation metric positional score to each holding that has received an evaluation metric stack ranking (or has received a proportional penetration percentage), wherein each evaluation metric positional score is based upon a holding's stack ranking (or has received a proportional penetration percentage) in an evaluation metric;

generating an overall score for each holding of the portfolio, wherein the overall score for a holding is based upon the evaluation metrics positional scores that are assigned to that holding;

performing evaluations of a given portfolio for successive time intervals (as financial information and data for a latter time period becomes publicly available) so to determine trends over successive time intervals, including trends for the overall scores, for any and all holdings; and

determining, within the selected time for the portfolio evaluation, a series of time cumulative intra-time-interval scores for each holding to show trends and inflection

points evident across successive time periods from a common base time period which the first time period of the selected time interval (see paragraphs 18-28 and abstract).

27. As per claim 2, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches wherein the step of generating an overall score for a holding comprises determining an average of the evaluation metric positional scores that are assigned to that holding (see paragraph 48).

28. As per claim 3, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches wherein the evaluation metric positional scores that are assigned to a holding are weighted differently and wherein the step of generating an overall score for a holding comprises determining a weighted average of the evaluation metric positional scores that are assigned to that holding (see paragraphs 55, 62-67 and 80-87).

29. As per claim 4, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches comprising: ranking the holdings of the portfolio based upon the overall scores that were assigned to each holdings; and generating an overall positional score for each holding, wherein a holding's overall positional score is based upon that holding's overall score ranking (see paragraphs 67 and 87).

30. As per claim 6, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches wherein each evaluation metric is characterized by a time domain aspect and a financial attribute aspect. The time domain aspect reflects the time dimension in which the value of the evaluation metric was calculated. For the majority of level evaluation metrics, the value of the evaluation metric is calculated at the point in

time marking the end of the selected time interval and reflect financial attributes of the holding's selected balance sheet position. "Flow" evaluation metrics are those for which the value of the evaluation metric represents the cumulative increase or decrease in dollar amount over the selected time interval for evaluation metrics and reflect financial attributes of the holding's profitability and cash consumption or generation. The majority of "change" evaluation metrics are those which reflect the degree to which the ratio factor from balance sheet line item at the point in time marking the end of the selected time interval has increased or decreased compared to the ratio factor at the point in time marking the start of the selected time interval change (see paragraphs 70-76 and 101-111).

31. As per claim 8, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches comprising: identifying a group of evaluation metrics from the set of evaluation metrics; generating a group score for each holding of the portfolio, wherein the group score for a holding is based upon the evaluation metric positional scores that are assigned to that holding for the group of evaluation metrics that are identified (see paragraphs 70-76 and 101-111).

32. As per claim 9, Siegel, JR. teaches the method of claim 8 as described above. Siegel, JR. further teaches wherein the step of generating a group score for a holding comprises determining an average of the evaluation metric positional scores that are assigned to that holding for the group of identified evaluation metrics (see paragraphs 62-67 and 80-87).

33. As per claim 10, Siegel, JR. teaches the method of claim 8 as described above. Siegel, JR. further teaches wherein the evaluation metric positional scores that are assigned to a holding are weighted differently and wherein the step of generating a group score for a holding comprises determining a weighted average of the evaluation metric positional scores that are assigned to that holding for the group of identified evaluation metrics (see paragraphs 62-67 and 80-87).

34. As per claim 11, Siegel, JR. teaches the method of claim 8 as described above. Siegel, JR. further teaches wherein each evaluation metric is characterized by a time domain aspect and a financial attribute aspect and wherein the group is identified based upon a time domain aspect, a financial attribute aspect or both (see paragraphs 70-76 and 101-111).

35. As per claim 12, Siegel, JR. teaches the method of claim 8 as described above. Siegel, JR. further teaches comprising: ranking the holdings of the portfolio based upon the group scores that were assigned to each holdings; and generating a group positional score for each holding, wherein a holding's group positional score is based upon that holding's group score ranking (see paragraphs 80-87).

36. As per claim 15, Siegel, JR. teaches the method of claim 8 as described above. Siegel, JR. further teaches wherein some evaluation metrics are based on the proprietary financial metrics of which one such financial metric is a holding's cumulative economic profit over, the selected time interval with this financial metric of not derived from P&L line items rather calculated from the absolute dollar change for specific Balance Sheet accounts over the selected time interval plus cumulative dollar amount of

dividends declared or paid over the selected time interval. For example, cumulative economic profit can be calculated as the dollar amount change in total shareholder equity from, the last period of the selected time interval as compared to the beginning of first time period of the selected time interval plus dividends declared or paid cumulatively for each for the time periods comprising the selected time interval less net equity capital that raised (e.g., from sales and redemption of shares) over the selected interval (see paragraphs 70-76 and 101-111).

37. As per claim 16, Siegel, JR. teaches the method of claim 15 as described above. Siegel, JR. further teaches wherein the cumulative economic profit financial metric accounts for special charges, non-operating losses and gains as well as other economic losses or gains that a holding has incurred whether or not all such losses and gains were reflected accurately the P&L statements for periods comprising the selected time interval (see paragraphs 70-76 and 101-111).

38. As per claim 19, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches wherein the organic shareholders equity financial metric reflects all of the business activities of the holding less cumulative dividends declared over the holding's life less net capital raised from a sale or redemption of the holding's stock (see paragraphs 70-76 and 101-111).

39. As per claim 20, Siegel, JR. teaches the method of claim 19 as described above. Siegel, JR. further teaches wherein some evaluation metrics are based the proprietary financial metric, organic shareholders equity, which reflects that portion of total shareholders equity generated from all operating and related activities (but not financing

activities) of the holding with the organic shareholder's equity financial metric calculated for the selected time interval by, among other ways, the net dollar change in retained earnings over the selected time interval less cumulative amount of dividends declared or paid by the holding over the life of the firm, Wherein unearned shareholders equity financial metric reflects that portion of total shareholders equity reflects the amount net capital that is raised from the sales (less repurchases) of common shares over the life of the enterprise (firm) from all financing activities of the holding (see paragraphs 70-76 and 101-111).

40. As per claim 21, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches wherein some evaluation metrics are based on the proprietary financial metric of which one such financial metric is organic cash, the pro forma amount cash that a holding would have had available both at the start and at the end of the time selected time interval had the holding never incurred any debt and had received no net cash from a sale or redemption of the holding's stock; one formula for calculating organic cash is all cash and cash equivalents less all debt obligations (short term and long term) less unearned shareholder equity at the end of the relevant time period. The change in organic cash over the selected time interval is a measures of capital consumption with the advantage of not relying on the accuracy of the reported, net income (in the P&L statement) from which the cash flow statement emanates (see paragraphs 70-76 and 101-111).

41. As per claim 42, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches wherein each evaluation metric comprising the set of

evaluation metrics (also called filters ,or filter ratios) can be computed from public financial information and from public financial data and each evaluation metric has a numerator and denominator with the denominator acting to neutralize the effect on the, value of an evaluation metric that would otherwise would has occurred because fundamental size of one enterprise (represented in the portfolio by a given holding for which quantified figurers have been captured from its financial statements) differs from the size of another enterprise (represented in the portfolio by another holding) with the terms "larger" and "size" as used here, not referring the number of shares of the holding represented in the portfolio or the percent of the total worth of the portfolio represented by a holding (see paragraphs 46-49).

42. As per claim 43, Siegel, JR. teaches the method of claim 1 as described above. Siegel, JR. further teaches wherein each evaluation, metric positional scores for a portfolio evaluation are based upon the stack ranking of the value for a holding's evaluation metric against the values of that evaluation metric for the other holdings in the portfolio (or, alternatively, the evaluation metric positional scores for a portfolio evaluation are based upon a holding's proportional penetration percentages with proportion penetration percentage relative the range bounded the highest value and value on in portfolio for the evaluation metric (see paragraphs 54 and 62-67).

43. Claim 44 recites similar limitations to claim 1 and thus rejected using the same art and rationale in the rejection of claim 1 as set forth above. Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the

skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Siegel, JR., it is within the basic knowledge of a skilled artisan that interpolating between two numbers or values is old and well known and commonly used in the art.

### ***Conclusion***

44. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz P. Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM

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